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09/674,600	12/13/2000	Lorenz Camenzind	P/543-103	1539

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EXAMINER

VERBITSKY, GAIL KAPLAN

ART UNIT PAPER NUMBER

2859

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/674,600

Applicant(s)

CAMENZIND ET AL.

Examiner

Gail Verbitsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 31-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on August 04, 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Restriction/ Election by Original Presentation**

1. Newly submitted claims 31-36 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
  - A) the originally claimed invention, i.e., claims 1-30, is directed to a multi functional tool.
  - B) the invention stated in newly submitted claims 31-36 is directed to a pocket knife.
  - C) the originally claimed invention classified in class 374, subclass 155.
  - D) the invention stated in claims 31-36 is classified in class 224, subclass 232.
2. Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation. Accordingly, claims 31-36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR and MPEP 821.03.

### ***Claim Objections***

3. Claims 11, 16 are finally objected to because of the following informalities:

Claim 11: perhaps applicant should replace "pressure sensor" in line 1 with

-- switch--, in order to clearly describe the invention.

Claim 16: "electronic circuitry" in line 2 lacks antecedent basis. Also, "it is not clear what particular structure applicant means. Does applicant mean a microprocessor, a converter, or a different structure? Furthermore, please note that in the rejection on the merit, the Examiner

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interprets the "electronic circuitry" as the microprocessor and/ or converter, claimed by applicant in claim 2. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6, 8, 9, 12, 15-16, 20 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Stanfield et al. (U.S. 5545855) [hereinafter Stanfield].

Stanfield discloses a tool (scale) 10 comprising a weighting hook (mechanical hand tool) 18 integrally attached by a hook and loop connection to a measuring and displaying device A, a load cell (measuring sensor/ scale/ weighting cell responding to a pressure) 30, a keypad 19, an electronics comprising a memory (storage device) to store data, a signal conditioning block (converter) 51 for converting a signal (weight/ physical value) in an electrical signal understandable by a processor (microprocessor) 52 which converts the signal in an electronic signal (electronic circuitry) displayed on the display in appropriate units (pounds) on an LCD 15. The electronic circuitry is mounted integrally (hook and loop connection) to the hand tool (hook) and can be released. The device can be on/ off. The device is operated by a power supply in a

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form of battery. (the numeral A has been added by the Examiner, see attachment to the Office Action).

With respect to the preamble of the claims: the preamble of the claim has not provided enough patentable weight because the court has held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

6. Claims 1, 3, 5-6, 12-15, 18, 21, 26 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Teare et al. (U.S. 5467656) [hereinafter Teare].

Teare discloses in Figs. 1-3 a multi functional tool/ device having a mechanical hand tool integrally or releasably attached to the device by a plug 24, wherein the device having a measuring and displaying device 22 and an LCD, and measuring sensors (plurality of measuring devices). The measured value is stored in a memory 172. Since Teare also teaches that the data can be transmitted to an external computer (col. 6, lines 21-22), it is inherent, that there is a device (interface) which permits this transmission and a communication can inherently be wireless, cable or optical. The device has two casing parts containing the inside of the device wherein, inherently, transmission of current and exchange of data is provided between electronic devices/ circuitry (microprocessor, memory, converter, etc.). Since the device is powered by a battery, it can inherently be on/off.

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***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2, 7-8, 12-14, 16-22, 24, 27-30 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Schaub in view of Hwang (U.S. 5883306).

Schaub discloses in Figs. 1-2 a modular (multi functional tool/pocket knife) device having a plurality of slidably interconnected modules, each module comprising tool hands 12, 13 which can be a sensor (col. 2, lines 36-38), at least two inner covers (casing/ modules) 20, 26, outer cover modules (cover plates) 23, 25 connected by connecting means (mechanical and electronic) 8, 11, 31, 35 and (pins) 36, 46, tor), a measuring and displaying device 21, releasably arranged by snapping in and out, an LCD display 70, a memory module (storing means) to store measured data, an emergency transmitter module (sending member) 1, batteries, entry keys (menu device) 22, watch. Schaub states that the number of modules can be expanded depending on the number of measuring devices contained in the modules. Schaub does not explicitly describe a microprocessor and a converter, however, it is very well known in the art, that an electronic calculator comprises a converter and a microprocessor. Inherently, the device comprises an interface in order to transmit an emergency signal to a receiving remote station

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(Emergency localization). Inherently, the device, and thus, the measuring and display device can be turned on/off.

As shown in Fig. 2, the cover plates are mounted (integrally) to the casing.

For claim 28: Also, as shown in Fig. 2, the cover plate can be removed (released) from the device should, for example, an additional module to be added (see attachment # 2 to the Office action).

For claim 29: means 23 is a cover plate, and the display is mounted onto the cover plate.

For claims 30: means 23 is a casing, and the display device 21 is mounted onto the casing.

Although, Schaub teaches sensors (col. 2, line 38), Schaub does not explicitly teach that the sensors measure a physical value and displaying said value on a measuring and displaying device, and a flash light (illuminating means).

Hwang discloses a multipurpose (multi functional) tool having measuring sensors, a measuring rod (hand tool) 51 and a measuring and display device to display a physical value (tire pressure) located in a main housing (casing). Hwang also discloses an illuminating unit comprising a light bulb (flash light) 71 capable of being on/off.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Schaub, so as to measure and display a physical value, as taught by Hwang, in order to provide the operator with a plurality of necessary data about an object of interest.

It would have also been obvious to one of ordinary skill in the art at the time the invention was made to add a flash light, as taught by Hwang, to the device disclosed by Schaub,

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so as to provide the operator with light which allows the operator to work in otherwise dark environment.

9. Claims 5, 11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Schaub and Hwang as applied to claims 1-2, 7-8, 12-14, 16-22, 24, 27-30 above, and further in view of Vinci (U.S. 5875413).

Schaub and Hwang disclose the device as stated above in paragraph 8.

They do not disclose a menu, as stated in claim 5, and a pressure sensor, as stated in claim 11.

Vinci discloses in Fig. 1 a plurality of measuring devices (sensors) and a menu circuit for selecting the respective sensor/ mode of operation (col. 1, line 47) and thus, displaying said mode of operation or a respective physical value. Vinci also discloses a pressure sensitive (pressure sensor) switch 106 by pressing on which the operator can obtain/ choose from a menu a pressure measurement on a display 112.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a menu operable by a switch, as taught by Vinci, to the device disclosed by Schaub and Hwang, so as to allow the operator to make the preferred selection, in order to make measurements needed to be done at the present time.



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10. Claim 10 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Schaub and Hwang as applied to claims 1, 2, 7-8, 12-14, 16-22, 24, 27-30 above, and further in view of La Neve (U.S. 634719).

Schaub and Hwang disclose the device as stated above in paragraph 8.

They do not disclose an awl and a feeler, as stated in claim 10.

La Neve discloses a tool (arm 16 with a spatula 14) comprising a retractable temperature sensing awl 10 with a temperature feeler 58.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a temperature sensing awl, as taught by La Neve, to the device disclosed by Schaub and Hwang, so as to make the device useful for a camping during a food preparation.

11. Claims 1, 8, 25 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Stanfield in view of Tymkewicz.

Stanfield discloses the device as stated above in paragraph 5.

Stanfield does not disclose that the device switches off automatically after a predetermined time, as stated in claim 25.

Tymkewicz teaches that the display turns off automatically after a period of time (col. 6, lines 61-64, col. 7, lines 42-45).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Stanfield, so as to turn the display off automatically after a period of time when the device is not used, in order to save life of battery and improve a longevity of the device.

12. Claim 23 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Schaub and Hwang as applied to claims 1-2, 7-8, 12-14, 16-22, 24, 27-30 above, and further in view of Shimizu et al. (U.S. 5798964) [hereinafter Shimizu].

Schaub and Hwang disclose the device as stated above in paragraph 8.

They do not disclose an access control circuit, as stated in claim 23.

Shimizu teaches an access control circuit which prevents undesirable access to the memory when the power is initially on.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add an access control circuit, as taught by Shimizu, to the device disclosed by Schaub and Hwang, so as to prevent undesirable access to the memory when the power is initially on, in order to protect the data from others.

### ***Response to Arguments***

13. Applicant's arguments filed on August 04, 2003 have been fully considered but they are not persuasive.

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With respect to Stanfield: Applicant states that Stanfield does not disclose a multi functional tool, and “the additional mechanical hand tool”. This argument is not persuasive because claim 1 of the instant invention has positively claimed only “at least one mechanical tool”. Also, the limitation stating “multi functional tool” is included in the preamble of the claim, the preamble of the claim has not provided enough patentable weight because the court has held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

With respect to Teare: Applicant states that the tool of the instant invention is not plugged into an exterior device. This argument is not persuasive because, although the Applicant does not explicitly claim “plugging in”, the applicant, (i.e., in claim 13) claims communication to an external device and does not rule out having a cable/ plug communication.

Applicant also states that “integrally or releasably” in Teare is self-contradictory. This argument is not persuasive because, it is possible that Teare discloses different embodiments with integral or releasable attachment. Also, according to Webster Dictionary, 10 th edition, page 607, “integrally” means “formed as a unit with another part, or composed of integral parts”. However, it does not mean that the parts can not be released. Furthermore, Applicant supports this statement in claim 16, where “... are mounted integrally to the tool and said parts are removably arranged...”.

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In addition, it has been held that the term “integral” is sufficiently broad to embrace constructions united by such means as fastening and welding. See In re Hotte, 177 USPQ 326, 328 (CCPA 1973).

Applicant states that Schaub *does not measure and display a physical value*. This argument is not persuasive because, the Examiner, in the rejection on the merits, uses Schaub in the 103 rejection in combination with Hwang, who teaches the this limitation. Therefore, the combination of Schaub and Hwang teaches this limitation.

With respect to Hwang: Applicant states that Hwang measures a tire depth and a tire pressure, and that Hwang teaches *no mechanical hand*. This argument is not persuasive because, Hwang teaches a measuring rod (mechanical tool/ hand) 51 to measure a physical value such as a depth or a pressure.

Applicant states that the Examiner has no motivation to combine Schaub and Hwang. This argument is not persuasive because, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). In this case, Schaub suggests to have a sensor, Hwang teaches to use a sensor to measure a physical value.

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With respect to claims 28-29: although, in the previous Office Action, the Examiner objected claims 28-29, after the Applicant clarified the relationship between the terms “cover plate” and “casing” by Examiner’s request, the Examiner has found that these claims also can be rejected over the applied references as necessitated by the amendment/ clarification.

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices.

16. Any inquiry concerning this communication should be directed to Examiner Verbitsky who can be reached at (703) 306-5473 Monday through Friday 7:30 to 4:00 ET.

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Any inquiry of general nature should be directed to the Group Receptionist whose telephone number is (703) 308-0956.

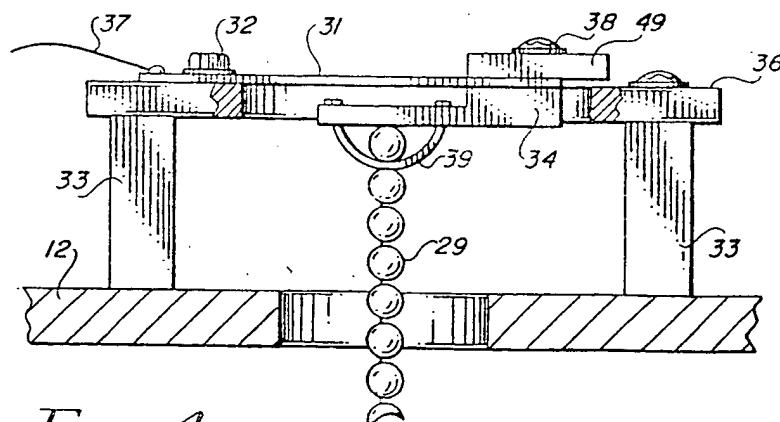
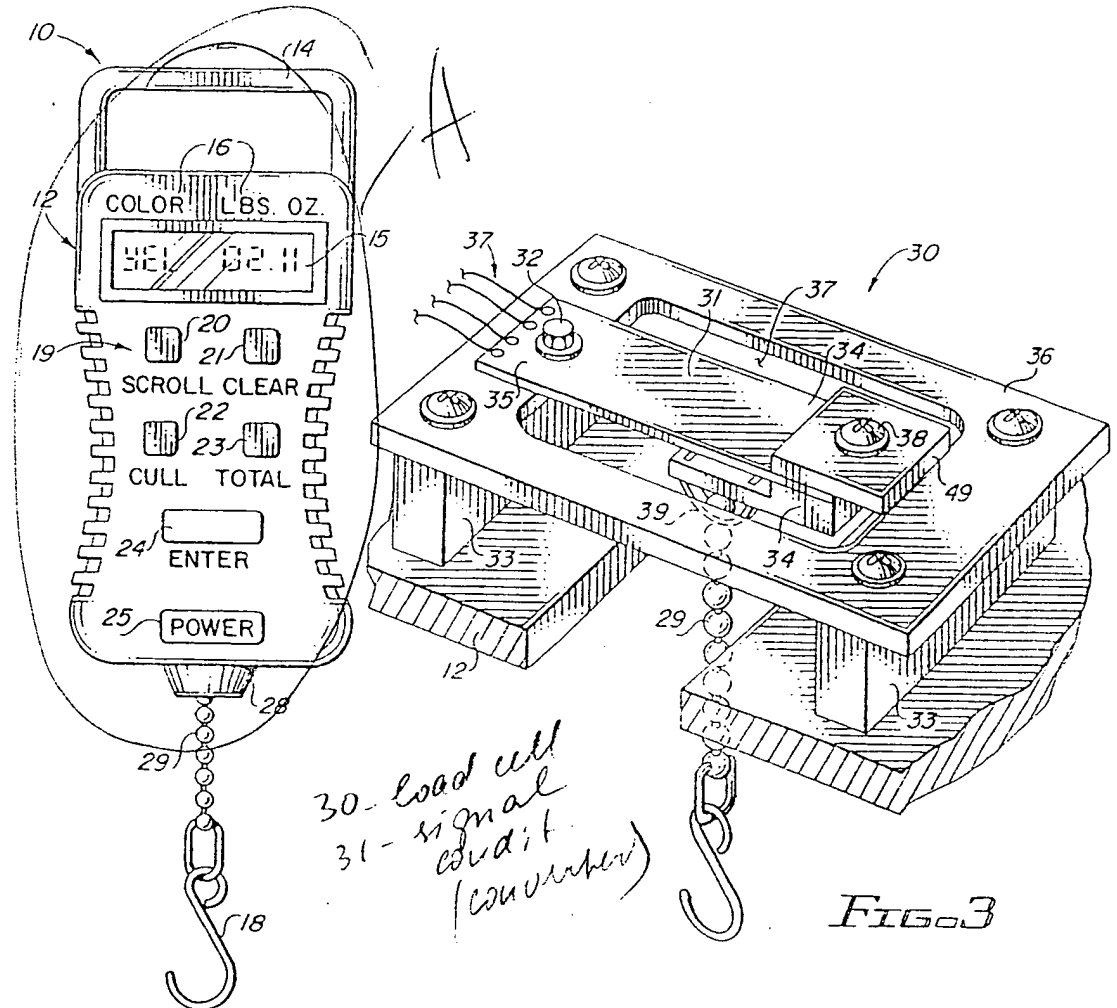
GKV

Gail Verbitsky

A handwritten signature in black ink, appearing to read 'G. Verbitsky', with a long horizontal flourish extending to the right.

31 October 2003

Patent Examiner, TC 2800



Attachment